

REMARKS

By this amendment, claims 1-6, 8-13, and 16-19 are pending, in which no claims are canceled, currently amended, or newly presented. Claims 7, 14, and 15 were previously canceled. Claims 20-23 are withdrawn. No new matter is introduced.

The final Office Action mailed January 12, 2006 rejected claims 1-6, 8-13, and 16-19 as obvious under 35 U.S.C. § 103 based on *Bogard* (US 6,757,365) in view of *Goodspeed* (US Pub. No. 2002/0065828 A1). Also, the Office Action has indicated that claims 20-23 are withdrawn from consideration based on a constructive election.

Applicants respectfully traverse the restriction requirement. MPEP § 803 states that “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” The claims of the present invention would appear to be part of an overlapping search areas, thus would not constitute a “serious burden.”

As regards the obviousness rejection, Applicants respectfully contend that a *prima facie* case of obviousness has not been established. Independent claim 1 recites “retrieving **an instant messaging identifier corresponding to the telephone number.**” Independent claim 18 recites “a processor configured to retrieve **an instant messaging identifier corresponding to a telephone number** of the called party for establishment of the end-to-end voice session via an instant messaging application of the called party.”

The Office Action (on page 3) correctly acknowledges the deficiency of *Bogard* by stating that the reference “does not teach using a telephone number to retrieve an instant messaging identifier.” Consequently, the Office Action is forced to rely on *Goodspeed* for a teaching of the “desirability of using a recipient’s telephone number for instant message

communication via a cross-referenced list of all handles belonging to the recipient.” Applicants respectfully submit that the Examiner misapplies the principles taught by *Goodspeed* in an attempt to modify the *Bogard* system to satisfy the claims. Consider, for example, that the claims recite use of an “instant messaging identifier,” while *Goodspeed* suggests using the telephone number itself to enable Internet communication, thereby negating the use of other “handles” all together. The Examiner misunderstands this distinction. Moreover, the suggestion by *Goodspeed* teaches away the claimed invention, in that *Goodspeed* seeks to strictly use telephone numbers for Internet communication and to eliminate other handles (e.g., instant messaging address).

In support of the rejection, the Office Action cites numerous passages. These cited passages, [0009], [0057], and [0060], state the following (Emphasis Added):

[0009] In view of the aforementioned problems with the current conventional approach to e-mail transmission, instant message transmission and web site access, the present invention provides significant improvement. This invention **allows an Internet user to access a web site directly by using at least one of the telephone numbers associated with the web site as the web site's URI/URL address.** This invention also **allows an Internet user to transmit an e-mail message or an instant message directly to an intended recipient by using one of the recipients telephone numbers directly as the e-mail address URI.** This invention allows all forms of Internet communication to be initiated using the telephone number as the basic URI or URL Internet address. This invention automatically gives every telephone number subscriber worldwide a personal web site Internet URI/URL addressable by telephone number and an Internet e-mail account URI/URL addressable by telephone number.

[0057] By way of this invention, **every telephone number worldwide becomes an identifying Internet URI/URL handle** or access key for use in information storage, transmission, retrieval and continuous monitoring/observation. This invention allows its users to monitor people, devices, equipment and resources and to be monitored by others by using various forms of telephone number URI/URL identifiers herein called handles. This invention allows users to publish for public or private access their telephone number or multiple telephone numbers and/or other handle(s) which include within them a telephone number. A handle may be any unique arbitrary collection of letters, numbers and special characters. A telephone number would be a type of handle, however not all handles are the same as telephone numbers. Some examples of handles include, but are not

limited to name (FIGS. 36 and 37), postal address, e-mail address, pager number or pin, instant messaging address, Social Security Number, PDA/PCD network identification/serial number, IP address, license plate or tag number (FIGS. 34A and 34B) or other arbitrary user created identifier. The invention allows an owner to create and maintain a large set of handles. **The invention maintains a cross reference list of all handles belonging to the same owner. Any handle which has as one of its component parts a telephone number formatted according to the rules of Table 1 shall be deemed to be owned (at least shared ownership if created by another party) and controlled by the owner/subscriber of that basic component telephone number. This invention makes the telephone number the unification address for electronic contact, messaging, status keeping and status seeking, tasking, schedule and time management, location tracking and ETD/ETA/ETC distance and speed calculation.** The invention is worldwide in scope and supports all languages and telephone number formats and international Internet character sets.

[0060] This invention makes it possible to enter a North American telephone number or International telephone number or other related handle directly into any Internet address field be it as a direct URL web address or as a direct URI e-mail address and have it produce immediately useful results via the invention system.

Applicants submit that one of ordinary skill in the art would conclude from the above passages that it would be undesirable to use any handle other than the actual telephone number. Accordingly, this teaches away “retrieving an instant messaging identifier corresponding to the telephone number,” as the *Goodspeed* system aims to avoid retrieving any handle other than the telephone number. The cross reference list merely maintains handles that have **“as one of its component parts a telephone number formatted according to the rules of Table 1.”** *Goodspeed* (in paragraph [0350]) discloses that “Table 1 lists various forms of acceptable telephone number or handle entry. The reason for the many different telephone number and handle address formats listed in Table 1 is to give examples of most of the likely ways that a person might enter a telephone number (North American (NANC/NANPA) or international) or other related handle.” Therefore, it is unequivocal that the *Goodspeed* attempts to only use the telephone number as the identifier for all Internet enable communications; consequently, in the context of the claims, there would be no need to “retrieve an instant messaging identifier.”

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In view of the foregoing, Applicants respectfully request withdrawal of the obviousness rejection, and the indication that independent claims 1 and 18 be allowed.

The rejection of dependent claims 2-6, 8-13, 16, 17, and 19 should likewise be withdrawn for at least the same reasons for the allowability of their respective independent claims. Additionally, these dependent claims are also patentable on their own merits. For example, dependent claim 16 recites “wherein the instant messaging identifier corresponds to a **time period designated for contacting the called party.**” The Office Action explains that “the user profile includes schedule information so that a call is automatically sent to a particular address according to the time of day,” citing paragraphs [0337] and [0340]. Applicants respectfully disagree with this interpretation. These passages state the following (Emphasis Added):

[0337] This invention also allows members to publish any (or all) of their telephone numbers or related handles as their primary electronic messaging or e-mail address or addresses. Others worldwide could then e-mail a message directly to them by simply knowing any one of the telephone numbers or handles of the recipient. There would be no need to call their number to get their e-mail address, instead, you would simply e-mail directly to any one of their known telephone numbers. **You do not have to know which particular number is best to e-mail to at a particular time of day because the invention will take care of that detail for you automatically.**

[0340] The invention allows users with multiple telephone numbers to associate their telephone numbers and handles with one another such that a message sent to any one of the associated handles can be automatically forwarded to any one or more of the associated telephone numbers or handles (FIG. 39). The message will be reformatted as needed to become compatible with the device to which it is being forwarded. The message can be automatically examined by owner defined table driven rules based procedures for content type and specific contents and reformatted, split apart and/or re-routed as specified. Alerts can be generated based upon the results of automated examination. The user who owns the associated handles can change the way in which a message to any one of their handles is routed to other electronic addresses. Those addresses can be telephone

numbers, handles, vanity e-mail addresses, ICQ/AOL instant message addresses or any other common form of electronic high level communications address scheme. A copy of the e-mail is also made available in the inventions telephone number based e-mail system, thus a telephone number owner can retrieve any mail sent to their telephone number directly from any Internet browser.

Given the above passage, at best, teaches that time of day is not necessary, thereby teaching away the claimed feature of **“a time period designated for contacting the called party”** ([0337]).

As another example, dependent claim 19 recites “wherein the instant messaging identifier is stored in a database configured to store user information that includes **an alias for uniquely identifying the called party in an instant messaging environment among a plurality of instant messaging environments and destination information specifying one or more communication devices for reaching the called party.**” This simply is not disclosed by *Goodspeed*, contrary to the Office Action’s assertion (page 4). The cited paragraphs of [0057] and [0340] merely describe in generalities possibilities for the handles, without any mention of the claimed alias or the claimed destination information.

The Examiner is reminded that 35 U.S.C. § 132 requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can

be identified early and the applicant can be given fair opportunity to respond.” To the contrary, the Examiner’s only discussion of the features of claims 16 and 19 is vague references to seemingly irrelevant passages.

Therefore, the present application overcomes the rejection of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date



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